

II. Remarks

A. Status of the Claims

Claims 1-128, 132, 150 and 151 are canceled without prejudice to filing in a continuing application. Claims 129-131, 144-148, 152-155, 157-162 and 164-174 are allowed. Claims 134, 149, 154 and 175 have been amended so as to further the present case to allowance. Claims 129-131, 133-149, and 152-175 are pending. Support for amended claim language is provided below. Applicants submit that no new matter has been introduced by the amendments.

B. Information Disclosure Statements

Filed concurrently herewith is a Supplemental Information Disclosure Statement (SIDS) listing patents, publications or other information (listed on the attached modified Form PTO 1449) which may be material to the patentability of this application and in respect of which there may be a duty to disclose in accordance with 37 CFR §1.56. Applicants respectfully request that documents listed in the concurrently-filed SIDS be reviewed by the Examiner and made of record in the application.

C. Claim Objections

The Final Office Action states an objection to Claims 134-143 for the term "aRNA" and to Claims 150 and 151 as improperly dependent upon Claim 129. Final Office Action at page 2.

Response

Claim 134 has been amended to recite "amplified RNA" to precede "aRNA," thereby providing the meaning of "aRNA" in the first occurrence thereof as requested by the Examiner and as supported by the specification at paragraph [0020].

Claims 150 and 151 are canceled without prejudice for filing in a continuing application.

Applicants therefore request that the objections to Claims 134-143 and 150-151 be withdrawn.

D. Rejection of Claims under 35 U.S.C. §112, Second Paragraph

Office Action

The Office Action states a rejection of Claims 132 and 133 as indefinite regarding the terms "purified" and "isolated," a rejection of Claim 149 as indefinite regarding "wild-type

RNase H activity,” a rejection of Claims 156 and 163 as indefinite for possible duplication of Claim 154, and a rejection of Claims 175 as indefinite for the phrase “one or more further reverse transcriptases.” Office Action at pages 2-4.

Response

Applicants traverse this rejection.

Claim 132 is canceled. Applicants submit that Claim 133 is definite due to the recitation of “wherein the reverse transcriptase is purified and is greater than 90% pure” since one of ordinary skill in the art would know how to measure enzyme purity.

Claim 149 has been amended to clarify that the wild-type RNase H activity refers to wild-type MMLV RNase H activity, which language has support in the title of column 3 of Table 4 on page 25 of the specification.

Claim 154 has been amended to recite “the reaction solution comprises a concentrated reverse transcriptase reaction buffer,” which phrase has support at paragraph [0019] of the specification (page 6, line 19) and which phrase distinguishes Claim 154 from Claim 156.

Claim 163 is an independent claim and is not duplicative of Claim 152 in that the reverse transcriptase of Claim 152 is that of Claim 129 which is to an isolated reverse transcriptase protein comprising SEQ ID NO:2.

Claim 175 has been amended to recite “wherein the container comprising a reverse transcriptase further comprises one or more further reverse transcriptases in addition to the reverse transcriptase comprising SEQ ID NO:2,” which language has support in the specification at paragraph [0022], page 7, lines 23-26.

In light of these remarks, Applicants respectfully request that the rejections under 35 U.S.C. §112, second paragraph, be withdrawn.

E. Rejection of Claims under 35 U.S.C. §112, First Paragraph

Office Action

The Office Action states a rejection of Claims 150 and 151 for failing to meet the written description and enablement requirements of 35 U.S.C. §112. Office Action at pages 4-9.

Response

Applicants traverse this rejection. However, in order to expedite prosecution of the present application to allowance, Applicants have canceled Claims 150-151. Applicants respectfully request that the rejections under 35 U.S.C. §112, first paragraph, be withdrawn.

F. Rejection of Claims under 35 U.S.C. §102

Office Action

The Office Action states a rejection of Claims 150 and 151 as anticipated by Ruppert (U.S. Patent No. 5,891,637). Office Action at page 9.

Response

Applicants traverse this rejection. However, in order to expedite prosecution of the present application to allowance, Applicants have canceled Claims 150-151. Applicants respectfully request that the rejection under 35 U.S.C. §102 be withdrawn.

G. Conclusion

Applicants believe that the foregoing remarks fully respond to all outstanding matters for this application. Applicants respectfully request reconsideration of the claimed invention and issuance of a Notice of Allowance for Claims 129-131, 133-149, and 152-175.

Should there be any questions or comments regarding this document, the Examiner is invited to contact Applicants' representative, Gloria L. Norberg at 512-721-3654 for discussion.

Applied Biosystems
2130 Woodward St.
Austin, Texas 78744
(512) 721-3654
(512) 721-3838 (facsimile)

Date: March 6, 2009

Respectfully submitted,

Gloria L. Norberg

Gloria L. Norberg, Ph.D., Patent Agent
Reg. No. 36,706
Agent for Applicants